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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,625	01/22/2004	Yaacov Almog	600204528-XUDS-A	7724

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HEWLETT PACKARD COMPANY
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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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04/16/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/763,625	Applicant(s) ALMOG ET AL.	
	Examiner Lawrence D. Ferguson	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38,40-43,45-48 and 51-58 is/are pending in the application.
- 4a) Of the above claim(s) 48 and 51-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38,40-43 and 45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Appeal Brief

1. Examiner regrets the untimely reopening of the case and withdraws the previous rejections to further prosecute the claimed invention. Claims 38, 40-43 and 45-47 are pending with claims 48 and 51-58 withdrawn as a non-elected invention.

In view of the Appeal Brief filed on December 17, 2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/David R. Sample/

Supervisory Patent Examiner, Art Unit 1794.

Claim Rejections – 35 USC § 102(b)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 38, 40, 42-43, 45 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Bodager et al. (U.S. 5,565,301).

Bodager discloses a coated paper substrate comprising a carrier support (1), which is a paper substrate (column 4, lines 55-67 and Figure 3) along with a carrier surface layer (2) that is a cushion layer, which is preferably ethylene acrylic acid copolymer (column 5, lines 15-16, 49-62 and Figure 3). Bodager further discloses an anchor layer between the carrier cushion layer and carrier support layer that comprises polyamides (column 6, lines 10-24). The anchor layer is a Macromelt (column 20, lines 59-60) which Applicant defines as an amine terminated polyamide in paragraph 0005 in the instant specification. Bodager discloses colored images (print) are formed on the article (column 1, line 6, column 2, lines 39-40, column 5, lines 38-45). The anchor layer remains adhesively bonded to the layers on both sides (has a high affinity for the substrate and overlayer) (column 6, lines 10-15). In claims 38 and 43, the phrase, “toner image can be fused and fixed” constitutes a ‘capable of’ limitation and that such a recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform. Additionally, in claims 38 and 43, the phrase,

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“for printing a toner image thereon” is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Because Bodager discloses a coated paper having the same layers, with the same materials it is inherent for the coated paper to be capable of being configured for printing a toner image thereon, as in claims 38 and 42-43 and 47.

Concerning claims 40 and 45, although the cushion layer can include additives as in column 5, line 66 through column 6, line 7, additives are not required in the layer; therefore it is reasonable to conclude that the layer is free of particulate matter.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 38, 40-41, 43 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimura et al. (U.S. 5,250,990) in view of Graham et al (U.S. 4,602,058).

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Fujimura discloses a coated paper substrate comprising a paper substrate (column 8, lines 24-26) coated with a photosensitive layer, where the photosensitive layer comprises a charge generation layer and charge transportation layer (column 7, line 67 through column 8, line 1) where the charge generation layer and charge transportation layers comprise styrene butadiene copolymer (column 7, lines 14-26, 56-57). Fujimura further discloses a polyamide primer layer can be provided between the substrate layer and photosensitive layer (column 8, lines 27-34) which can be printed with a toner image (column 1, lines 13-23). In claim 38, the phrase, “toner image can be fused and fixed” constitutes a ‘capable of’ limitation and that such a recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform. Additionally, in claim 38, the phrase, “for printing a toner image thereon” is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Fujimura does not disclose the polyamide layer is an amine terminated polyamide. Graham teaches a coated paper, where two layers are bonded together using an amine-terminated polyamide interlayer (column 11, lines 46-53, column 12, lines 60-68 and column 13, lines 1-4). Fujimura and Graham are combinable because they are related to a similar technical field, which is coated papers. It would have been obvious to one of ordinary skill in the art to substitute the amine terminated polyamide

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coating layer of Graham for the polyamide primer (coating) layer of Fujimura because Graham teaches polyamide layers are commercially made using amine-terminated polyamides (column 5, lines 33-38 and column 11, lines 46-53 of Graham), as in claim 38 and 41.

Concerning claims 40 and 45, the photosensitive layer appears to be free of particulate matter.

Concerning claims 43 and 46, the article is image forming and can be printed (column 1, lines 13-15). Because Fujimura and Graham disclose a printed article having a paper substrate coated with an underlayer and overlayer having similar materials, it is expected for the underlayer to have a high affinity for the substrate, for the overlayer to have a high affinity for toner and for the underlayer and overlayer to have high affinity for each other, absent any evidence to the contrary. In claim 43, the phrase, "toner image can be fused and fixed" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Additionally, in claim 43, the phrase, "for printing a toner image thereon" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Response to Arguments

6. Applicant's arguments of the rejection made under 35 U.S.C. 103(a) as being unpatentable over Lever et al. EP 0458481 in view of Ellery et al (U.S. 5,631,078) are moot based on grounds of new rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample, can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lawrence Ferguson/
Patent Examiner, Art Unit 1794

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1794